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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,351	08/31/1999	EDWIN JAMES DUMORRIS EDDY	P-6374.03	2510

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 03/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/380,351

Applicant(s)  
Eddy et al.

Examiner  
Clark F. Dexter

Art Unit  
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Dec 28, 2001

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 26-33, 36-48, and 50 is/are pending in the application.

4a) Of the above, claim(s) 27-33, 38-47, and 50 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 26, 36, 37, and 48 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: ☒ approved ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☒ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

Art Unit: 3724

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on December 28, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/380,351 is acceptable and a CPA has been established. An action on the CPA follows.
2. The preliminary amendment filed December 28, 2001 has been entered. It is noted that in view of the new amendment practice under 37 CFR 1.121 which became mandatory for all amendments on March 1, 2001, and due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s). It is further noted that the clean version(s) is (are) considered to be the Official version(s).

### ***Claim Objections***

3. Claims 26<sup>x</sup>, 36<sup>x</sup> and 37<sup>x</sup> are objected to because of the following informalities:

In claim 26, line 7, "whereby," is improper and the comma should be deleted and reinserted before "whereby". Appropriate correction is required.

Art Unit: 3724

***Claim Rejections - 35 USC § 112***

4. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 37, lines 1-2, structural cooperation is lacking for "a roller".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 26 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller, pn 4,452,118.

Muller discloses a device with every structural limitation of the claimed invention including separation unit having a cutter (e.g., 30); support means (e.g., structure upstream and downstream of the cutter); feeder means comprising a pusher arm (e.g., 58); and means to constrain lateral movement comprising at least one pair of horizontally spaced apart guide rollers (e.g., 146).

Art Unit: 3724

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 37 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller, pn 4,452,118.

Regarding claim 37, Muller lacks the separation device comprising a roller. However, the Examiner takes Official notice that such rollers are old and well known in the art for various well known benefits including reducing vibrations of the work piece during a cutting operation. Therefore, it would have been obvious to one having ordinary skill in the art to provide rollers on one or both sides of the cutter (i.e., upstream and downstream) to gain the various known benefits including that described above.

Regarding claim 48, Muller discloses a process with every active method step of the claimed invention but lacks the work piece being metallic. However, the Examiner takes Official notice that it is old and well known in the art to cut various types of elongate metallic members longitudinally. Therefore, it would have been obvious to one having ordinary skill in the art to use the cutting device of Muller to cut an elongate metallic member to longitudinally split the member into two pieces.

Art Unit: 3724

*Response to Arguments*

9. Applicant's arguments filed December 28, 2001 have been fully considered but they are not persuasive.

In the fourth paragraph on page 4 of the amendment, applicant argues that “[I]f Muller’s separation unit is taken to end at the cutter 30, then while Muller’s support table 36 provides for a degree of support downstream thereof, it could not and does not support the fully separate pieces of a blank.” The Examiner respectfully submits that applicant’s argument is not understood and it is not clear how applicant intends the claimed invention to distinguish over the prior art. First, there appears to be no recitation in the claims that the fully separated pieces be supported. Second, and more importantly, applicant appears to be trying to distinguish the claimed invention over the prior art by the type of work piece that is being cut. This, however, is directed to functional recitation of an intended use of the device which, as is well settled in case law, cannot serve to distinguish an invention over the prior art. Further, if it is argued that the functional recitation somehow infers additional structure of the device, it is not clear what such structure would be. However, it is clear that shorter work pieces than that shown by Muller can be cut by Muller’s device, and such work pieces would clearly be fully supported by the support means of Muller.

In the fifth paragraph on page 4 of the amendment, applicant argues that “another of the elements of amended Claim 26 is not met, namely that, ‘... separated parts of said elongate metallic member issuing from said separation unit are free to move laterally with respect to said

Art Unit: 3724

cutter.” Again, it is respectfully submitted that applicant’s argument is not understood. Again, applicant appears to be trying to distinguish the claimed invention by the type of work piece being cut. As previously stated, this is directed to a functional recitation of an intended use of the device which, as is well settled in case law, cannot serve to distinguish an invention over the prior art. Further, if it is argued that the functional recitation somehow infers additional structure of the device, it is not clear what such structure would be. However, it is clear that there is no structure between the cutter 30 and the outfeed drive rolls 34 that would prohibit lateral movement of the separated parts.

In the paragraph bridging pages 4-5 of the amendment, applicant argues that “Muller does not teach or disclose the element of the pusher arm as claimed in amended claim 26.” Again, applicant’s argument is unclear as to how the claimed invention structurally distinguishes over the prior art. Muller clearly discloses a pusher arm (e.g., 58) that is upstream of the separation unit for pushing a work piece. No further structural requirement appears to be set forth, thus Muller discloses the claimed structure including such a pusher arm.

In the second paragraph on page 5 of the amendment, applicant argues that the recitation “... whereby such support means downstream of said separation unit receives and supports separated sections of said elongate member issuing from the separation unit” is not taught by Muller. The Examiner respectfully disagrees. Muller clearly discloses a support means downstream of the separation unit, and this support means clearly “receives and supports separated sections of said elongate member issuing from the separation unit.”

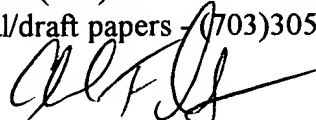
Art Unit: 3724

In the fourth paragraph on page 5 of the amendment, applicant argues that "Muller teaches the use of power driven fee (i.e., feed) rollers to push and pull blank 28 through the separation unit. This is unacceptable in metal cutting; and, therefore, teaches away from the present invention." However, the Examiner respectfully submits that applicant's argument is not persuasive, particularly since applicant has provided no evidence to support the conclusion. It is the Examiner's position that it is old and well known in the art to use a sawing device, particularly a rotary sawing device, to cut metallic work pieces. Therefore, to use the apparatus of Muller to cut metallic work pieces, particularly elongate metallic work pieces, would have been an obvious use of Muller's device.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

  
**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
March 20, 2002



**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.